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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,723	04/11/2001	Christopher J. Murray	GC617-2	9743

5100 7590 04/19/2004

GENENCOR INTERNATIONAL, INC.
ATTENTION: LEGAL DEPARTMENT
925 PAGE MILL ROAD
PALO ALTO, CA 94304

EXAMINER	
TRAN, MY CHAU T	

ART UNIT	PAPER NUMBER
1639	

DATE MAILED: 04/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/832,723	MURRAY ET AL.	
	Examiner	Art Unit	
	MY-CHAU T TRAN	1639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 January 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-32* is/are pending in the application.

4a) Of the above claim(s) *1-19 and 21-32* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *11 April 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *5/6/02*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. Claims 1-32 are pending.

Election/Restrictions

2. Applicant's election without traverse of Group 3 (Claim 20) in Paper filed 1/28/04 is acknowledged.

3. Claims 1-19, and 21-32 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to ***nonelected inventions***, there being no allowable generic or linking claim. Election was made **without** traverse in Paper filed 1/28/04.

Priority

4. This application claims priority to a provisional application, 60/197,259, filed 4/14/2000.

Information Disclosure Statement

5. The information disclosure statement (IDS) submitted by applicant filed on 5/6/02 is acknowledged and considered as noted on PTO-1449.

6. Claim 20 is treated on the merit in this Office Action.

Claim Objections

7. Claim 20 is objected to because it depends on the method of claims 1 and 3 that are drawn to non-elected inventions. Appropriate correction is required.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. The instant claim 20 recites a peptide that is identified by the method for screening a peptide library. This claim is written as product-by-process claim.

10. Claim 20 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Cwirla et al. (*PNAS*, **1990**, 87(16):6378-6382).

Cwirla et al. disclose peptides derive from the screening method of biopanning (Abstract; pg. 6380, left col., lines 18-57). The screening method comprises the step of binding the library of peptides to antibodies and isolating the bound complex.

Alternatively, the claimed invention further differs from the prior art teachings only by the recitation of the screening method. The claimed invention appears to be the same or obvious variations of the reference teachings, absent a showing of unobvious differences. The office does not have the facilities and resources to provide the factual evidence needed in order to determine and/or compare the specific activities of the instant versus the reference screening

method. In the absence of evidence to the contrary, the burden is upon the applicant to prove that the claimed peptide identified by the claimed screening method is different from the one taught by prior art and to establish the patentable differences. See *In re* Best 562F.2d 1252, 195 USPQ 430 (CCPA 1977) and *Ex parte* Gray 10 USPQ2d 1922(PTO Bd.Pat. App. & Int. 1989).

"Even though the product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability is based on the product itself. The patentability of a product does hot depend on its method of production. If the product in the product-by-process claims is same or as obvious from the product of the prior art, the claim is unpatentable even though the prior art product was made by a different process." In re Thorpe, 777 F. 2d 695, 698, 227 U. S. P. Q. 964, 966 (Fed. Cir. 1985). (see MPEP 2113).

11. Claim 20 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hanes et al. (*PNAS*, **1997**, 94(10):4937-4942).

Hanes et al. disclose antibodies (peptide) derive from the screening method of the affinity selection by ribosome display (Abstract; fig. 1; pg. 4940, left col., line 44 to right col., line 28). The screening method comprises the step of binding the antibodies to the immobilized antigen and isolating the bound complex.

Alternatively, the claimed invention further differs from the prior art teachings only by the recitation of the screening method. The claimed invention appears to be the same or obvious variations of the reference teachings, absent a showing of unobvious differences. The office does not have the facilities and resources to provide the factual evidence needed in order to determine and/or compare the specific activities of the instant versus the reference screening

method. In the absence of evidence to the contrary, the burden is upon the applicant to prove that the claimed peptide identified by the claimed screening method is different from the one taught by prior art and to establish the patentable differences. See *In re* Best 562F.2d 1252, 195 USPQ 430 (CCPA 1977) and *Ex parte* Gray 10 USPQ2d 1922(PTO Bd.Pat. App. & Int. 1989).

"Even though the product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability is based on the product itself. The patentability of a product does hot depend on its method of production. If the product in the product-by-process claims is same or as obvious from the product of the prior art, the claim is unpatentable even though the prior art product was made by a different process." In re Thorpe, 777 F. 2d 695, 698, 227 U. S. P. Q. 964, 966 (Fed. Cir. 1985). (see MPEP 2113).

12. Claim 20 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Schatz et al. (US Patent 5,270,170).

Schatz et al. disclose peptides derive from the screening method (Abstract; col. 2, lines 26-32, and 51-63). The screening method comprises the step of contacting the fusion protein of the peptide library with a receptor for binding and isolating the bound complex.

Alternatively, the claimed invention further differs from the prior art teachings only by the recitation of the screening method. The claimed invention appears to be the same or obvious variations of the reference teachings, absent a showing of unobvious differences. The office does not have the facilities and resources to provide the factual evidence needed in order to determine and/or compare the specific activities of the instant versus the reference screening method. In the absence of evidence to the contrary, the burden is upon the applicant to prove

that the claimed peptide identified by the claimed screening method is different from the one taught by prior art and to establish the patentable differences. See *In re* Best 562F.2d 1252, 195 USPQ 430 (CCPA 1977) and *Ex parte* Gray 10 USPQ2d 1922(PTO Bd.Pat. App. & Int. 1989).

"Even though the product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability is based on the product itself. The patentability of a product does hot depend on its method of production. If the product in the product-by-process claims is same or as obvious from the product of the prior art, the claim is unpatentable even though the prior art product was made by a different process." In re Thorpe, 777 F. 2d 695, 698, 227 U. S. P. Q. 964, 966 (Fed. Cir. 1985). (see MPEP 2113).

13. Claim 20 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over The University Court of The University of Glasgow (refers to as Glasgow) (WO 99/06542; *filing date of 2/11/1999*).

Glasgow discloses peptides derive from the screening method of biopanning (Abstract; fig. 1; pg. 11, line 27 to pg. 12, line 2; pg. 13, line 15-25). The screening method comprises binding the library of peptides to a ligand and isolating the bound complex.

Alternatively, the claimed invention further differs from the prior art teachings only by the recitation of the screening method. The claimed invention appears to be the same or obvious variations of the reference teachings, absent a showing of unobvious differences. The office does not have the facilities and resources to provide the factual evidence needed in order to determine and/or compare the specific activities of the instant versus the reference screening method. In the absence of evidence to the contrary, the burden is upon the applicant to prove

that the claimed peptide identified by the claimed screening method is different from the one taught by prior art and to establish the patentable differences. See *In re* Best 562F.2d 1252, 195 USPQ 430 (CCPA 1977) and *Ex parte* Gray 10 USPQ2d 1922(PTO Bd.Pat. App. & Int. 1989).

"Even though the product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability is based on the product itself. The patentability of a product does hot depend on its method of production. If the product in the product-by-process claims is same or as obvious from the product of the prior art, the claim is unpatentable even though the prior art product was made by a different process." In re Thorpe, 777 F. 2d 695, 698, 227 U. S. P. Q. 964, 966 (Fed. Cir. 1985). (see MPEP 2113).

Conclusion

14. No claim allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MY-CHAU T TRAN whose telephone number is 571-272-0810. The examiner can normally be reached on Mon.: 8:00-2:30; Tues.-Thurs.: 7:30-5:00; Fri.: 8:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ANDREW WANG can be reached on 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mct
April 15, 2004

PADMASHRI PONNALURI
PRIMARY EXAMINER